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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91209825
Party	Defendant PYR Less Group, LLC
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

KISS MY FACE, LLC,

Opposer,

V.

PYR LESS GROUP, LLC,

Applicant.

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Opposition No. 91209825

APPLICANT'S TRIAL BRIEF

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I. **PRELIMINARY STATEMENT:**

A “touch” is not the same as a “kiss” in the eyes of purchasers. TOUCH and KISS are different in sound, appearance, connotation, and commercial impression. You can touch someone with your hands, your knee, or the top of your head, but you can only kiss with your lips. This is a common, even universally known use of the words. Because of the differences in Applicant’s mark TOUCH MY FACE and Opposer’s mark KISS MY FACE, no consumer of these products will be confused into thinking they are the same products or emanate from the same source.

Applicant’s mark, TOUCH MY FACE, when used in connection with Applicant’s goods, does not create a likelihood of confusion, mistake, or deception as to source or sponsorship with Opposer’s mark. Specifically,

1. The dominant portions of Applicant’s mark and Opposer’s marks are the distinct elements TOUCH and KISS, rather than the shared, descriptive element MY FACE, and the dominant elements TOUCH and KISS are different in sound, appearance and connotation and create separate, distinct commercial impressions in the eyes of consumers so as not to create a likelihood of confusion.
2. Applicant’s mark and Opposer’s marks have been used concurrently for almost thirteen (13) years, and during the time that the marks have coexisted, there has not been a single instance of any actual confusion.

3. Opposer's KISS MY FACE marks are not strong when used in relation to personal beauty products, many of which are used on consumers' faces, and as evidenced by numerous third-party registrations and marks in the personal beauty product space incorporating KISS or MY FACE.
4. The goods sold using Applicant's mark and Opposer's marks are marketed and sold as all-natural, high-end beauty products to consumers who will carefully consider and research all-natural beauty products. Applicant's product is considerably more expensive than Opposer's product.

II. **PROCEDURAL HISTORY:**

On June 27, 2012, Applicant filed trademark application Serial Number 85/663,155 for the word mark TOUCH MY FACE for use in connection with "facial masks; non-medicated serums for use on skin," in International Class 3. The date of first use of the mark in commerce is August 8, 2002. The Trademark Examining Attorney cited no basis for refusal of the registration of Applicant's mark TOUCH MY FACE.

The PTO published application Serial Number 85/663,155 on November 20, 2012. Opposer filed a First 90 Day Request for Extension of Time to Oppose for Good Cause on December 19, 2012. The TTAB granted Opposer's request on December 19, 2012, and Opposer was extended time to oppose Applicant's application until March 20, 2013. On March 19, 2013, Opposer KISS MY FACE filed a Notice of Opposition. In the Notice of Opposition, Opposer alleged priority of use of the KISS MY FACE mark and a likelihood of confusion between its federally registered KISS MY FACE trademark and

Applicant's TOUCH MY FACE trademark, pursuant to Section 2(d) of the Lanham Act, 15 U.S.C. §1052(d).

III. **DESCRIPTION OF THE RECORD:**

A. **AUTOMATICALLY OF RECORD**

The file of the subject application, Opposer's Notice of Opposition, and Applicant's Answer to Notice of Opposition are of record pursuant to 37 C.F.R. § 2.122. On October 2, 2014, the parties also filed a Stipulation of the Parties (Dkt. 18.), stipulating as to the authenticity and admissibility of the following documents and testimony:

1. Documents produced by either party during discovery in this proceeding;
2. Discovery depositions taken of Applicant's 30(b)(6) witnesses;
3. Opposer and Applicant's responses to interrogatories and requests for admission in this proceeding; and
4. The records from TSDR for the following U.S. Registrations:
 - a. U.S. Registration No. 4450642 KISS MY FACE and Design
 - b. U.S. Registration No. 4450641 KISS MY FACE and Design
 - c. U.S. Registration No. 4268625 KISS MY FACE PEACE and Design
 - d. U.S. Registration No. 4229593 KISS MY FACE
 - e. U.S. Registration No. 4200053 KISS MY FACE SHIMMER
 - f. U.S. Registration No. 3120784 KISS MY FACE WHITENING
 - g. U.S. Registration No. 3590613 KISS MY FACE MOISTURE SOAP
 - h. U.S. Registration No. 2706187 KISS MY FACE
 - i. U.S. Registration No. 2301324 KISS MY FACE

j. U.S. Registration No. 1991868 KISS MY FACE

k. U.S. Registration No. 1513297 KISS MY FACE

B. APPLICANT'S EVIDENCE

Applicant filed Applicant's Notice of Reliance on January 19, 2015 (Applicant's "NOR") (Dkt. 25 and 26), indicating its intent to rely on the following evidence:

1. True and correct printouts of the dictionary definitions of the words "kiss" and "touch" from the online dictionary, www.merriam-webster.com (Dkt. 25, Ex. 1).
2. True and correct copies of excerpts of the transcripts of the 30(b)(6) discovery deposition of Applicant, via Applicant's owner, Dr. Roby Mitchell (*Id.* Ex. 2) and Applicant's employee, Ms. Jodi Bytheway (*Id.* Ex. 3).
3. True and correct copies of documents produced by Applicant during the discovery period showing Applicant's TOUCH MY FACE products (*Id.* Ex. 4).
4. True and correct copies of documents produced by Applicant during the discovery period showing Applicant's Facebook page and Applicant's website and Applicant's marketing materials (*Id.* Ex. 5).
5. True and correct copies of the following discovery responses:
 - a. Applicant's Response to Kiss My Face's First Set of Interrogatories, Document Requests, and Requests for Admission (*Id.* Ex. 6).

- b. Applicant's Responses to Kiss My Face's Second Set of Interrogatories, Document Requests, and Requests for Admission to Applicant (*Id.* Ex. 7).
 - c. Opposer's Responses to Applicant's First Request for Production of Documents and Things (*Id.* Ex. 8).
 - d. Opposer's Responses to Applicant's First Set of Interrogatories (*Id.* Ex. 9).
6. TSDR printouts for the following U.S. Registrations, which are owned by Opposer (*Id.* Ex. 10):
- a. U.S. Registration No. 4450642 KISS MY FACE and Design
 - b. U.S. Registration No. 4450641 KISS MY FACE and Design
 - c. U.S. Registration No. 4268625 KISS MY FACE PEACE and Design
 - d. U.S. Registration No. 4229593 KISS MY FACE
 - e. U.S. Registration No. 4200053 KISS MY FACE SHIMMER
 - f. U.S. Registration No. 3120784 KISS MY FACE WHITENING
 - g. U.S. Registration No. 3590613 KISS MY FACE MOISTURE SOAP
 - h. U.S. Registration No. 2706187 KISS MY FACE
 - i. U.S. Registration No. 2301324 KISS MY FACE
 - j. U.S. Registration No. 1991868 KISS MY FACE
 - k. U.S. Registration No. 1513297 KISS MY FACE
 - l. U.S. Registration No. 4636349 ONE KISS IS ALL IT TAKES
 - m. U.S. Registration No. 3005002 FACE FACTOR

7. TSDR printout of the specimen submitted with the trademark application packet for U.S. Registration No. 4636349 ONE KISS IS ALL IT TAKES (*Id.* Ex. 11).
8. TSDR printouts for the following U.S. Registrations, which are owned by third-parties (*Id.* Ex. 12):
 - a. U.S. Registration No. 2616120 KISS
 - b. U.S. Registration No. 2859222 KISS MY FEET
 - c. U.S. Registration No. 1656563 LOVE MY FACE
 - d. U.S. Registration No. 3752063 KISS-A-LICIOUS
 - e. U.S. Registration No. 0805324 LOVE & KISSES
 - f. U.S. Registration No. 1960708 KISS ME IN THE GARDEN
 - g. U.S. Registration No. 3064786 KISS ME
 - h. U.S. Registration No. 3516538 KISS-ABLE
 - i. U.S. Registration No. 4272862 KISS IN THE CITY
 - j. U.S. Registration No. 4255407 SHINY KISS
 - k. U.S. Registration No. 4222884 NATURAL KISS
 - l. U.S. Registration No. 3972035 BEST KISS
 - m. U.S. Registration No. 4169072 SECRET KISSES and Design
 - n. U.S. Registration No. 4045282 SECRET KISSES
 - o. U.S. Registration No. 4077175 KISS OF HOPE
 - p. U.S. Registration No. 4147695 ISLAND KISS
 - q. U.S. Registration No. 4050904 HEALTHY KISS

- r. U.S. Registration No. 3054775 TROPICAL KISS
 - s. U.S. Registration No. 3362516 KISS & TELL
 - t. U.S. Registration No. 2942310 KISS & TELL
 - u. U.S. Registration No. 3146305 KISS-A-PEEL
 - v. U.S. Registration No. 4020156 KISS THE EARTH NATURALS
 - w. U.S. Registration No. 4020153 KISS THE EARTH MINERALS
 - x. U.S. Registration No. 3732770 KISS NEW YORK and Design
 - y. U.S. Registration No. 3628644 DR. KISS
 - z. U.S. Registration No. 2208168 KISS OF FIRE
 - aa. U.S. Registration No. 1878194 THE KISS
 - bb. U.S. Registration No. 3824289 TOUCH MY SKIN FOR EXTERNAL USE ONLY and Design
 - cc. U.S. Registration No. 3944504 MYFACE
 - dd. U.S. Registration No. 3920122 MYFACE.COSMETICS
 - ee. U.S. Registration No. 4330303 TREASURED KISS
9. Screen shot of list of TESS search results for “KISS and 003[IC]” returning 973 records (*Id.* Ex. 13).
 10. Screen shot of list of TESS search results for “TOUCH and 003[IC]” returning 1,205 records (*Id.* Ex. 14).
 11. Screen shot of list of TESS search results for “FACE and 003[IC] and FACE[DS]” returning 380 records (*Id.* Ex. 15).

12. True and correct copies of documents produced by Opposer during the discovery period showing KISS MY FACE products (*Id.* Ex. 16).
13. True and correct copies of documents produced by Opposer during the discovery period showing Opposer's Facebook page and Opposer's marketing materials (Dkt. 26, Ex. 17).
14. Screen shot of Opposer's Facebook page promoting Opposer's "Kiss Across America" contest and describing the contest (*Id.* Ex. 18).
15. True and correct copies of documents produced by Opposer during the discovery period showing Opposer's enforcement efforts. These documents have been designated as CONFIDENTIAL by Opposer and have been filed separately as CONFIDENTIAL (*Id.* Ex. 19).
16. Applicant will also rely upon the testimony deposition and exhibits annexed thereto of Ms. Jean Fufidio, Opposer's Chief Marketing Officer. Ms. Fufidio's deposition along with the exhibits annexed thereto was submitted to the Trademark Trial and Appeal Board on December 30, 2014, under Opposer's Notice of Filing Trial Testimony (Dkt. 23 and 24).
17. Applicant will also rely on any evidence submitted with Opposer's Notice of Reliance.

C. OPPOSER'S EVIDENCE

Opposer filed a Notice of Reliance on November 20, 2014 (Opposer's "NOR") (Dkt. 19 and 20), indicating its intent to rely on the following evidence:

1. True and correct printouts of the dictionary definitions for the words “kiss” and “touch” from the Merriam-Webster online dictionary (Dkt. 19, Ex. 1).
2. True and correct copies of documents produced by Opposer during discovery in this proceeding showing KISS MY FACE facial care products (*Id.*, Ex. 2).
3. True and correct copies of documents produced by Opposer during discovery in this proceeding showing a variety of KISS MY FACE products (*Id.*, Ex. 3).
4. True and correct copies documents produced during discovery in this proceeding showing Opposer’s Facebook page and Opposer’s marketing materials (*Id.*, Ex. 4).
5. TSDR printouts for Opposer’s U.S. Registrations (*Id.*, Ex. 5).
6. True and correct copies of excerpts of the transcripts of the 30(b)(6) discovery deposition² of Applicant, via its owner, Mr. Roby Mitchell and Applicant’s employee, Ms. Jodi Bytheway (*Id.*, Exs. 6 and 7).
7. True and correct copies of Applicant’s Response to Interrogatories, Document Requests, and Requests for Admission (*Id.*, Ex. 8).
8. True and correct copies of documents produced by Opposer during discovery in this proceeding showing Opposer’s enforcement efforts (Dkt. 19 and 20, Opposer’s NOR, Ex. 9).
9. True and correct copies of the of documents produced by Applicant during discovery in this proceeding showing the price of Applicant’s TOUCH MY

FACE goods and sales of said products from 2008 to 2013 (Dkt. 20, Opposer's NOR, Ex. 10).

10. The 30(b)(6) testimony deposition of Opposer, via Opposer's Chief Marketing Officer, Ms. Jean Fufidio, dated November 17, 2014, with accompanying Opposer's Exs. 1 through 6 and Applicant's Exs. A through F. (Dkt. 23 and 24).

IV. **STATEMENT OF FACTS**

A. **DEVELOPMENT OF TOUCH MY FACE**

Applicant began selling TOUCH MY FACE products in the office practice of Dr. Roby Mitchell and in pharmacies in 2002, and Applicant continues to sell TOUCH MY FACE products in these channels today. (Dkt. 25, Applicant's NOR Ex. 2 June 13, 2014 Deposition of Dr. Roby Mitchell (June 13, 2014 Mitchell Dep.) 9:49-20). Dr. Mitchell's office practice "consults individuals on health and nutrition and offers products to facilitate health." (*Id.* at 9:11-13). Since the initial sales in 2002 through Dr. Mitchell's office and pharmacies, Applicant has expanded its sales and promotion of TOUCH MY FACE goods to health food type companies, doctor's offices and online. (Dkt. 25, Applicant's NOR Ex. 2 June 13, 2014 Mitchell Dep. 8:1-4, 10:6-9; Ex. 3 Deposition of Ms. Jodi Bytheway (Bytheway Dep.) 7:22-23).

Both parties' goods are products that may be used on the faces of consumers. Applicant currently offers facial serums, facial masks and soaps under its mark TOUCH MY FACE. (Dkt. 1, Notice of Opposition, U.S. Ser. No. 85/663,155; Dkt. 25, Ex. 3 Bytheway Dep. 14:18-22; Ex. 4 PYR000106-8; Ex. 6 Interrogatory Resp. 4). Opposer's

goods include facial cleansers, facial lotions, facial creams, facial gels, and facial masks. (Dkt. 25, Applicant's NOR Ex. 9, Interrogatory Resp. No. 7; Ex. 10, U.S. Reg. Nos. 2,301,324, 4,229,593, 4,268,625, 4,450,641, 4,450,642).

Applicant developed the products sold under TOUCH MY FACE as a result of the demand from Dr. Mitchell's clients who "have an interest in beauty, so they will ask for things to help their skin look better." (Dkt. 25, Applicant's NOR Ex. 2. June 30, 2014 Deposition of Dr. Roby Mitchell (June 30, 2014 Mitchell Dep.) 5:11-18). The target consumer for Applicant's TOUCH MY FACE products is anyone with skin blemishes or wrinkles on their face. (Dkt. 25, Applicant's NOR Ex. 6 Interrogatory Resp. 6). Dr. Mitchell developed TOUCH MY FACE products to assist in mitigating certain skin conditions that can be caused by inflammatory responses to organism overgrowth. (Dkt. 25, Applicant's NOR Ex. 2 June 30, 2014 Mitchell Dep. 6:14-25, 7:1-4).

B. MORE EXPENSIVE, HIGH-END PRODUCTS SOLD BY TOUCH MY FACE AND KISS MY FACE

Applicant's TOUCH MY FACE masks and serums sell for between \$21.75 and \$43.45. (Dkt. 20, Opposer's NOR Ex. 10; Dkt. 25, Applicant's NOR Ex. 3 Bytheway Dep. 10:6-23; Ex. 7 Request for Admission Resps. 39, 40). The goods sold under Opposer's mark KISS MY FACE are natural products that are "little bit more expensive," according to Applicant, at a price between \$5.99-\$21.99. (Dkt. 23, Deposition of Ms. Jean Fufidio (Fufidio Dep.) 29:6-16, 30:2-7). Applicant's TOUCH MY FACE products are priced higher than Opponent's admittedly "expensive" products (Dkt. 20, Opposer's NOR Ex. 10; Ex. 3 Bytheway Dep. 10:6-23; Ex. 7 Request for Admission Resps. 39, 40;

Dkt. 23, Fufidio Dep. 29:6-16, 30:2-7). When asked about the target consumers for Opposer, Ms. Fufidio testified:

Our target market is women 24 to 39 years old, who we consider them to be – who they consider themselves to be natural thinking consumers. They're women who like natural products, understand the benefits of the product, and want products that are good and healthy for your skin. They usually have a higher income because natural products are a little bit more expensive, so that's who we're talking to.

(Dkt. 23, Fufidio Dep. 29:22-25, 30:2-7). Ms. Fufidio further testified that a consumer survey showed that sixty-eight percent (68%) of consumers that took the survey used words like all natural and earth friendly to describe Opposer's brand. (*Id.* at 18:15-25, 19:2-4).

C. OPPOSER'S BRAND BUILT AROUND KISS

Opposer's brand is built around the word KISS, and KISS is the first term in all the registrations relied on by Opposer in this proceeding. (Dkt. 1 Notice of Opposition; Dkt. 25 Applicant's NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 1,991,868, 2,301,324, 2,706,187, 3,005,002, 3,120,784, 3,590,613, 4,200,053, 4,229,593, 4,268,625, 4,636,349, 4,450,641, and 4,450,642). Ms. Fufidio repeatedly testified that Opposer systematically uses words like "kiss," "kissably," and "kissers" in association with its business because it reinforces Opposer's brand with consumers. (Dkt. 23, Fufidio Dep. at 30:13-15, 31:3-7, 32:19-21, 33:15-18, 37:4-10, 38:8-11, 24-25, 39:2-13, 46:3-16, 55:6-20, 59:5-8, 60:13-24, 65:6-18, 68:20-25, 69:18-23, 72:12-19, 25, 73:2-12, 74:11-25, 75:2, 78:14-25, 79:2-6, 80:14-16). Opposer emphasizes the word "kiss" or some variation thereof and the act of kissing on its marketing and advertising materials to reinforce the connection between its

products and the word KISS. (Fufidio Dep. Ex. 6 KMF7, 64; Dkt. 26, Applicant's NOR Ex. 17, KMF21, 31-33, 49, 51 401). Opposer's new tagline for its products is "One kiss is all it takes." (Dkt. 23, Fufidio Dep. at 31:6-7; Dkt. 25, Applicant's NOR Ex. 11, PYR000112). Opposer calls its customers and Facebook fans "kissers" and refers to its founders as "chief kissers" in order to reinforce Opposer's brand with consumers. (Dkt. 23, Fufidio Dep. at 45:21-25, 46:2-16; Dkt. 26, Applicant's NOR Ex. 17, KMF167-173). Opposer has never called its customers or founders "touchers" or "facers." (Dkt. 23, Fufidio Dep. at 46:17-25, 47:2-13).

Opposer desires its place in the market to be the product that provides kissably soft skin from head to toe. (Dkt. 23, Fufidio Dep. at 30:13-16, 37:4-10). Opposer had an entire social marketing campaign around the word KISS and the act of kissing in order to reinforce its brand with the word KISS among consumers. (Dkt. 23, Fufidio Dep. 53:15-25; 54:13-24, 55:9-10, 17-20; Dkt. 26, Applicant's NOR Ex. 18, PYR000109-111). Opposer emphasizes the word KISS because it is the first word of its brand and it reinforces its brand. (Dkt. 23, Fufidio Dep. 46:6-11).

KISS is located in large font and at the top of Opposer's products. (Dkt. 25, Applicant's NOR Ex. 16 KMF2, 58, 84, 102, 103). Opposer presents its mark KISS MY FACE as being read vertically from top to bottom, with the smaller word MY sandwiched in between KISS and FACE. (*Id.*) Applicant presents its mark TOUCH MY FACE as being read left to right, with all the words in the same size font. (*Id.* Ex. 4).

D. EXTENSIVE THIRD-PARTY REGISTRATION USE OF KISS AND FACE FOR PERSONAL COSMETIC PRODUCTS

There are at least twenty-seven (27) third-party registrations on the Principal Register that include the word “kiss” or “kisses” and include personal cosmetic goods. (Dkt. 25, Applicant’s NOR Ex. 12). There are at least three (3) third-party registrations on the Principal Register that include the words “my face” and include personal cosmetic goods. (*Id.*). When asked if she was surprised that multiple products came back in the results when the word “kiss” was entered in the search engine on Walgreens’ website, Ms. Fufidio responded “That doesn’t surprise me.” (Dkt. 23, Fufidio Dep. 49:3-11). Ms. Fufidio agreed that “kiss” was a fairly common term in the beauty industry. (*Id.* at 49:12-15).

Opposer believes that it should have the right to exclude anybody from using marks that contain “kiss my” or “my face” in International Class 3. (*Id.* at 40:7-22). Opposer has been required to disclaim the term “face” in at least three (3) of its registrations (Dkt. 25, Applicant’s NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 3,005,002, 4,268,625). Many of Opposer’s products are used on the faces of consumers. (Dkt. 25, Applicant’s NOR Ex. 9, Interrogatory Resp. No. 7; Ex. 10, U.S. Reg. Nos. 2,301,324, 4,229,593, 4,268,625, 4,450,641, 4,450,642).

E. NO ACTUAL CONFUSION AMONG CONSUMERS BETWEEN TOUCH MY FACE AND KISS MY FACE

Applicant selected the mark TOUCH MY FACE because it expressed the experience a customer would have after using the product. (Dkt. 23, Applicant’s NOR Ex. 6 Interrogatory Resp. 1). Nobody associated with Applicant had any knowledge of

Opposer or Opposer's marks prior to the selection by Applicant of TOUCH MY FACE. (*Id.* at Interrogatory Resp. 3).

Applicant has sold goods under the TOUCH MY FACE mark continuously since August 12, 2002. (Dkt. 25, Applicant's NOR Ex. 2 June 13, 2014 Mitchell Dep. 9:14-20; U.S. Ser. No. 85/663,155). Ms. Fufidio testified that she is unaware of a single instance of actual confusion among consumers between Applicant's mark TOUCH MY FACE and Opposer's mark KISS MY FACE. (Dkt. 23, Fufidio Dep. 51:16-25, 52:2-12). This is despite the fact that Ms. Fufidio testified that she believed TOUCH MY FACE and KISS MY FACE were in similar channels of trade and were exposed to the same consumers. (Dkt. 23, Fufidio Dep. 50:6-25, 51:2-4). In its Answers to Interrogatories, Opposer answered that it was not aware of a single instance of actual confusion among consumers between TOUCH MY FACE and KISS MY FACE. (Dkt. 25, Applicant's NOR Ex. 9, Interrogatory Resp. No. 6). Opposer has never been contacted by any consumer, intentionally or unintentionally, about any type of connection or relationship between TOUCH MY FACE and KISS MY FACE. (Dkt. 23, Fufidio Dep. 51:16-25, 52:2-11).

F. LACK OF DECISIONS ON THE MERITS OF OPPOSER'S ENFORCEMENT EFFORTS

Opposer's enforcement efforts have consisted of an extensive number of cease and desist letters and opposition proceedings, none of which have ever reached the merits of Opposer's position. (Dkt. 26, Applicant's NOR Ex. 19). Zero (0) of the eighteen (18) opposition proceedings relied on by Opposer as successful enforcement efforts have

reached the merits of the case. Specifically, the outcome of each opposition proceeding relied on by Opposer is the following:

1. Opposition No. 91214547 – No-answer default
2. Opposition No. 91208333 – No-answer default
3. Opposition No. 91218622 – Pending motion for summary judgment by applicant
4. Opposition No. 91205250 – Agreed abandonment of application
5. Opposition No. 91216331 – No-answer default
6. Opposition No. 91169326 – No-answer default
7. Opposition No. 91171928 – No-answer default
8. Opposition No. 91200578 – Settled between the parties
9. Opposition No. 91190868 – Abandonment of application by applicant
10. Opposition No. 91184808 – Abandonment of application by applicant
11. Opposition No. 91183926 – No-answer default
12. Opposition No. 91182031 – Abandonment of application by applicant
13. Opposition No. 91182032 – Abandonment of application by applicant
14. Opposition No. 91177675 – Abandonment of application by applicant
15. Opposition No. 91171841 – No-answer default
16. Opposition No. 91157334 – Abandonment of application by applicant
17. Opposition No. 91121709 – Settled between the parties
18. Opposition No. 91207794 – Abandonment of application by applicant.

V. **QUESTION PRESENTED**

The sole issue before the Board pursuant to Section 2(d) of the Lanham Act is whether or not Applicant's mark TOUCH MY FACE, when applied to Applicant's goods, is likely to cause confusion, mistake, or deception as to source or sponsorship with Opposer's registrations for KISS MY FACE. 15 U.S.C. § 1052(d).

VI. **ARGUMENT**

A. **WEIGHT GIVEN TO EACH *DUPONT* FACTOR**

If no evidence is submitted regarding a particular factor, that factor need not be considered in the analysis. On this score, *DuPont* itself teaches that the relevant factors, “*when of record*, must be considered.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973) (emphasis added). A single *DuPont* factor may be dispositive if that factor outweighs all the others which may be pertinent in the case. *Kellogg Co. v. Pack’Em Enterprises, Inc.*, 951 F.2d 330, 333, 21 USPQ2d 1142 (Fed. Cir. 1991).

B. **FACTOR 1: SIMILARITY OR DISSIMILARITY OF THE MARKS IN THEIR ENTIRETIES AS TO APPEARANCE, SOUND, CONNOTATION AND COMMERCIAL IMPRESSION**

There is no likelihood of confusion between Applicant's mark TOUCH MY FACE and Opposer's mark KISS MY FACE because the dominant features of the mark are the distinct elements TOUCH and KISS rather than the shared, descriptive element MY FACE. The dominant, distinct elements TOUCH and KISS differ in appearance, sound, connotation and commercial impressions in the eyes of consumers so as not to create a likelihood of confusion.

Marks are compared in their entireties for similarities in appearance, sound, connotation, and commercial impression. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361. The focus is on the recollection of the average purchaser, who normally retains a general rather than specific impression of trademarks. *L'Oreal S.A. v. Marcon*, 102 USPQ2d 1434, 1438 (TTAB 2012).

The dominant features of the marks, TOUCH and KISS, are different. It is well established that there is nothing improper in giving more or less weight to a particular portion of the mark. *Hewlett-Packard Co. v. Packard Press, Inc.*, 281 F.3d 1261, 1265-66, 62 USPQ2d 1001, 1003 (Fed. Cir. 2002); *In re Nat'l Data Corp.*, 753 F.2d 1056, 1058, 224 USPQ 749, 750-51 (Fed. Cir. 1985). In identifying the dominant feature of the mark, it is often the first and most prominent term of the mark that is most likely “to be impressed upon the mind of the purchaser and remembered.” *Joel Gott Wines LLC v. Rehoboth Von Gott Inc.*, 107 USPQ2d 1424, 1430 (TTAB 2013) (quoting *Presto Products, Inc. v. Nice-Pak Products, Inc.*, 9 USPQ2d 1895, 1897 (TTAB 1988)).

Here, the first, most prominent and dominant portion of Applicant’s mark is TOUCH and Opposer’s mark is KISS. KISS is the first term in all the registrations relied on by Opposer in this proceeding. (Dkt. 1 Notice of Opposition; Dkt. 25 Applicant’s NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 1,991,868, 2,301,324, 2,706,187, 3,005,002, 3,120,784, 3,590,613, 4,200,053, 4,229,593, 4,268,625, 4,636,349, 4,450,641, and 4,450,642). Opposer emphasizes the word “kiss” and “kissably soft skin” and the act of kissing when promoting and advertising its products. (Dkt. 23, Fufidio Dep. at 30:13-15, 31:3-7, 32:19-21, 33:15-18, 38:24-25, 39:2-13, 65:6-18, 68:20-25, 69:18-23; Fufidio

Dep. Ex. 6 KMF7, 64; Dkt. 26, Applicant's NOR Ex. 17, KMF21, 31-33, 49, 51 401). Opposer's new tagline for its products is "One kiss is all it takes." (Dkt. 23, Fufidio Dep. at 31:6-7; Dkt. 25, Applicant's NOR Ex. 11, PYR000112). Opposer calls its customers and Facebook fans "kissers" and refers to its founders as "chief kissers" in order to reinforce Opposer's brand with consumers. (Dkt. 23, Fufidio Dep. at 45:21-25, 46:2-16; Dkt. 26, Applicant's NOR Ex. 17, KMF167-173). Opposer has never called its customers or founders "touchers" or "facers." (Dkt. 23, Fufidio Dep. at 46:17-25, 47:2-13).

Opposer desires its place in the market to be the product that provides kissably soft skin from head to toe. (Dkt. 23, Fufidio Dep. at 30:13-16, 37:4-10). Opposer had an entire social marketing campaign around the word KISS and the act of kissing in order to reinforce its brand with the word KISS among consumers. (Dkt. 23, Fufidio Dep. 53:15-25; 54:13-24, 55:9-10, 17-20; Dkt. 26, Applicant's NOR Ex. 18, PYR000109-111). Opposer emphasizes the word KISS because it is the first word of its brand and it reinforces its brand. (Dkt. 23, Fufidio Dep. 46:6-11).

Consumers do not associate Opposer's brand with the words TOUCH or MY FACE—Opposer's brand is built around the word KISS. The first, most prominent and dominant portion of Applicant's mark is TOUCH and Opposer's mark is KISS. Ms. Fufidio repeatedly testified that Opposer systematically uses words like "kiss," "kissably," "kissers," "chief kissers," and depictions of people kissing in association with its business because it reinforces Opposer's brand with consumers. (Dkt. 23, Fufidio Dep. 37:4-10, 38:8-11, 46:3-16, 55:6-20, 59:5-8, 60:13-24, 72:12-19, 25, 73:2-12, 74:11-25, 75:2, 78:14-25, 79:2-6, 80:14-16). Opposer emphasizes the word "kiss" or some variation

thereof and the act of kissing on its marketing and advertising materials to reinforce the connection between its product and the word KISS. (Dkt. 23, Fufidio Dep. Ex. 6, KMF7, 30, 38, 40, 42, 64, 397; Dkt. 26, Applicant's NOR Ex. 17, KMF401). Because of the focus on the word KISS and its connection to Opposer, it is not likely that a consumer would see TOUCH MY FACE and confuse the mark with Opposer.

A "touch" is not the same as a "kiss" in the eyes of purchasers. The ordinary meanings of words can be different despite the fact that the words may share a similar association in the words' dictionary definitions. *Lever Bros. Co. v. Babson Bros. Co.*, 197 F.2d 531, 533, 94 USPQ 161, 163 (CCPA 1952). In *Lever Bros.*, the court found that consumers could appreciate the distinction between the simple, well-known words "surf" and "surge," and that "surf" and "surge" "do not ordinarily have the same significance or connotation, notwithstanding that one of the six dictionary definitions of the word 'surge' is similar to the definition of the word 'surf.'" *Id.* (quoting opinion of examiner-in-chief). Further, Professor McCarthy states, "If two conflicting marks each have an aura of suggestion, but each suggests something different to the buyer, this tends to indicate a lack of a likelihood of confusion." 3 MCCARTHY ON TRADEMARKS § 23:28. "To count as a factor pointing away from confusion, the different meanings of the conflicting words must be understood among those in the target buyer class." *Id.*

"Touch" and "kiss" are simple, well-known words. Each word suggests something different in the minds of consumers. Consumers can understand and appreciate that a kiss is a form of touch but not all touches are kisses. Three of the eight Merriam-Webster's definitions of "kiss" contain the word "touch." (Dkt. 25, Applicant's NOR, Ex. 1).

However, similar to *Lever Bros.*, the fact that three out of eight definitions of “kiss” includes the word “touch” holds little probative value as to whether or not consumers can understand and appreciate that a “touch” is different than a “kiss.” *Lever Bros. Co. v. Babson Bros. Co.*, 197 F.2d at 533. The first definition of “kiss” in Merriam-Webster’s dictionary is “to touch with the *lips especially* as a mark of affection or greeting.” (Dkt. 25, Applicant’s NOR, Ex. 1) (emphasis added).

The word “kiss” suggests some contact involving lips. Opposer has admitted that “kiss” suggests contact involving lips. (Dkt. 23, Fufidio Dep. 41:15-18, 82:13-18). The word “touch” does not have such a narrow distinction. KISS suggests contact with the lips especially. TOUCH does not. When somebody asks you to touch their face, the first thought and mental imagery is not a kiss. Potential purchasers understand the difference between touching somebody’s face and kissing somebody’s face. The words TOUCH and KISS create separate and distinct connotations in the eyes of purchasers, and there is no likelihood of confusion among consumers between Applicant’s mark and Opposer’s mark.

Consumers are not likely to be confused between Applicant’s mark and Opposer’s mark because consumers will look to the distinct, well-known elements TOUCH and KISS to determine the source of the goods rather than the shared, weak, descriptive element MY FACE. “That a particular feature is descriptive or generic with respect to the involved goods or services is one commonly accepted rationale for giving less weight to a portion of the mark.” *In re Nat’l Data Corp.*, 753 F.2d at 1058. If the shared elements of the marks are weak and the remaining features are sufficiently different to distinguish

them in the minds of consumers, there is no likelihood of confusion. *Stouffer Corp. v. Health Valley Natural Foods*, 1 USPQ2d 1900, 1903 (TTAB 1987). In *Stouffer*, the Board found there was no likelihood of confusion between LEAN LIVING and LEAN CUISINE because the common element “lean” was weak and was “at least, highly suggestive of both parties’ goods.” *Id.*

Likewise, there was no likelihood of confusion between SANDWICH CHEF and BURGER CHEF because the shared term “Chef” was weak and insufficient to create a likelihood of confusion and the terms “Sandwich” and “Burger” were dominant, distinct features of the marks. *Burger Chef Sys., Inc. v. Sandwich Chef, Inc.*, 608 F.2d 875, 878, 181 USPQ 168, 169 (CCPA 1979). The Federal Circuit has affirmed the Board’s holding that there is no likelihood of confusion as a matter of law when the marks are readily distinguishable in appearance and the main point of similarity is a merely descriptive component of both parties’ marks. *See Keebler Co. v. Murray Bakery Prods.*, 866 F.2d 1386, 1390, 9 USPQ2d 1736, 1739 (Fed. Cir. 1989) (finding no likelihood of confusion between PECAN SHORTEES and PECAN SANDIES, both for cookies, because the shared term “pecan” is “merely descriptive of a principal ingredient of both parties’ cookies”). Finally, there was no likelihood of confusion between SILK and SILK ‘N SATIN for beauty products because

The obvious substantial differences between the marks are enough to prevent any reasonable likelihood of confusion, mistake or deception when the marks are applied to the respective goods, especially considering the suggestive nature of the term SILK which [applicant] admits to exist in this field.


Pacquin-Lester Co. v. Charmaceuticals, Inc., 484 F.2d 1384, 1385, 179 USPQ 45, 46 (CCPA 1973).

Similar to *Stouffer, Burger Chef*, and *Keebler*, the shared element MY FACE in this case is weak, descriptive of the parties' goods, and at least highly suggestive of both parties' goods. Both parties' goods are products that may be used on the faces of consumers. Opposer's goods include *facial* cleansers, *facial* lotions, *facial* creams, *facial* gels, and *facial* masks. (Dkt. 25, Applicant's NOR Ex. 9, Interrogatory Resp. No. 7; Ex. 10, U.S. Reg. Nos. 2,301,324, 4,229,593, 4,268,625, 4,450,641, 4,450,642) (emphasis added). Applicant's goods include *facial* masks. (Dkt. 1, Notice of Opposition, U.S. Ser. No. 85/663,155) (emphasis added). Like *Pacquin-Lester*, there are obvious substantial differences between TOUCH MY FACE and KISS MY FACE, especially considering the suggestive nature of FACE which Opposer has been required to disclaim in multiple registrations. *Pacquin-Lester Co. v. Charmaceuticals, Inc.*, 484 F.2d at 1385. (Dkt. 25, Applicant's NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 3,005,002, 4,268,625). If the terms "Burger" and "Sandwich," both in the food space, are distinct features of two marks to avoid a likelihood of confusion (*see Burger Chef Sys., Inc. v. Sandwich Chef, Inc.*, 608 F.2d at 878), then the terms TOUCH and KISS are certainly separate and distinct enough so as not to create a likelihood of confusion among consumers.

The Trademark Office requires disclaimers when the mark is registrable as a whole but contains an unregistrable component. 15 U.S.C. § 1056(a); *see also* TRADEMARK MANUAL OF EXAMINING PROCEDURE (TMEP) § 1213. Matter that is not registrable is a mark or matter that when used in connection with the goods of the

applicant is merely descriptive of them. 15 U.S.C. § 1052(e)(1). The major reasons for not protecting merely descriptive marks are to prevent the owner from inhibiting competition in the sale of particular goods and to maintain freedom of the public to use the terms involved. *In re Abcor Development Corp.*, 588 F.2d 811, 813, 200 USPQ 215, 217 (CCPA 1978).

Because FACE is highly suggestive and descriptive of products used on consumers' faces, the Trademark Office has required Opposer to disclaim "face" in at least three (3) of its registrations. Specifically, Opposer has been required to disclaim any right to "face" outside of the marks in the following registrations:

Mark	Required Disclaimer	Registration No.	Goods
KISS MY FACE	FACE	1,513,297	Personal care products – namely, shampoos, soaps, creme rinses, skin toners and skin lotions
 KISS MY FACE PEACE	FACE	4,268,625	Personal care products including, <i>inter alia</i> , facial creams
FACE FACTOR	FACE	3,005,002	<i>Facial</i> cream

(Dkt. 25, Applicant's NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 3,005,002, 4,268,625) (emphasis added).

Despite these required disclaimers of the word FACE, Ms. Fufidio testified that Opposer would have issues with anybody trying to register any mark that contains “my face” in International Class 3. (Dkt. 23, Fufidio Dep. 41:6-10). Opposer should not have the right to exclude Applicant, a competitor of Opposer, from using a term that Opposer has been required to disclaim in its registrations. In determining the source of the goods, consumers will look to the separate and distinct elements TOUCH and KISS which create separate, distinct commercial impressions in the eyes of consumers. Thus, there is not a likelihood of confusion among consumers.

TOUCH and KISS do not look alike and do not sound alike. There is no likelihood of confusion because Applicant’s mark TOUCH MY FACE is different in appearance and sound when compared to Opposer’s mark KISS MY FACE. Marks may be similar in meaning but so distinct as to sound and appearance that any similarity in meaning is overcome, thereby precluding any likelihood of confusion. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d 158, 160, 117 USPQ 295, 296 (CCPA 1958). In *Sure-Fit*, the court held that there was no likelihood of confusion between SURE-FIT and RITE-FIT when used in conjunction with slip covers. *Id.* The court held that the shared word FIT was weak and descriptive when used in relation to slip covers, and that the elements SURE and RITE were different in sound and meaning so as not to create a likelihood of confusion. *Id.* In its holding, the court in *Sure-Fit* stated:

Under these circumstances, we do not feel that appellant is entitled to the broad protection which it seeks. What appellant is in effect asking us to do is to allow it, at least insofar as registration is concerned, to preempt the field as far as the word “Fit” is concerned. We cannot avoid this conclusion despite the fact that appellant stresses the fact that the prefixes “Rite” and

“Sure” have the same number of letters and syllables. The fact of the matter is that “Rite” and “Sure” do not look alike or sound alike, factors which we feel, at least in this case, militate against appellant’s position.

Id.

TOUCH and KISS neither look alike nor sound alike. They have a different number of letters. They do not share a single letter. Opposer presents its mark KISS MY FACE as being read vertically from top to bottom, with the smaller word MY sandwiched in between KISS and FACE. (Dkt. 25, Applicant’s NOR Ex. 16 KMF2, 58, 84, 102, 103). Applicant presents its mark TOUCH MY FACE as being read left to right, with all the words in the same size font. (*Id.* Ex. 4). As previously discussed, TOUCH and KISS may be similar in meaning insomuch as a kiss is a type of touch, but differences in sound and appearance may preclude any likelihood of confusion. *Sure-Fit Prods. Co. v. Saltzson Drapery Co.*, 254 F.2d at 160. Similar to *Sure-Fit*, the conclusion here is that Opposer is requesting the Board to allow Opposer to preempt the field of personal cosmetic products as far as the term MY FACE is concerned, despite having been required to disclaim “face” in three different registrations. *Id.* (Dkt. 25, Applicant’s NOR Ex. 10, U.S. Reg. Nos. 1,513,297, 3,005,002, 4,268,625). MY FACE is weak, descriptive and not entitled to broad protection when used in relation to personal cosmetic products, many of which are used on consumers’ faces.

When viewed in their entirety, Applicant’s mark TOUCH MY FACE is not likely to be confused with Opposer’s marks KISS MY FACE among consumers because: (i) the dominant features of the marks are the distinct elements TOUCH and KISS, respectively, rather than the shared element MY FACE; (ii) consumers appreciate and

understand that a “touch” is not the same thing as a “kiss” despite some similar dictionary definitions; (iii) the parties’ marks neither look alike nor sound alike; and (iv) Opposer’s advertising and marketing efforts have reinforced the association among consumers with the word “kiss,” not “touch,” and Opposer’s products.

Accordingly, this factor weighs against a finding of likelihood of confusion. In this case, this single factor outweighs all others that may be pertinent and is dispositive of the issue presented to the Board. *Kellogg Co. v. Pack’Em Enterprises, Inc.*, 951 F.2d at 333.

C. FACTOR 6: THE NUMBER AND NATURE OF SIMILAR MARKS IN USE ON SIMILAR GOODS

There is no likelihood of confusion between Applicant’s mark TOUCH MY FACE and Opposer’s marks KISS MY FACE because the existence of numerous third-party registrations and third-party marks incorporating the word KISS used in relation to personal cosmetic goods shows that Opposer’s KISS MY FACE marks are weak, or at least that Opposer’s KISS MY FACE marks are neither particularly strong nor entitled to broad protection.

In *King Candy Co. v. Eunice King’s Kitchen, Inc.*, the court explained that:

[t]he expressions “weak” and “entitled to limited protection” are but other ways of saying, as the board went on to recognize in its opinion therein, that confusion is unlikely because the marks are of such non-arbitrary nature or so widely used that the public easily distinguishes slight differences in the marks under consideration as well as differences in the goods to which they are applied, even though the goods of the parties may be considered “related.”

King Candy Co. v. Eunice King’s Kitchen, Inc., 496 F.2d 1400, 1401, 182 USPQ 108, 109 (CCPA 1974). Third-party registrations incorporating a particular term can serve to

negate a claim of exclusive rights in the term. *Sweats Fashions Inc. v. Pannill Knitting Co. Inc.*, 833 F.2d 1560, 1564-5, 4 USPQ2d 1793, 1797 n.1 (Fed. Cir. 1987).

Further, the existence of multiple marks on the Principal Register containing a shared term in use with similar goods indicates a weak basis for asserting a likelihood of confusion. *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d 1163, 1173 (TTAB 2011). As the Board stated in *Top Tobacco*,

The fact that the USPTO has allowed so many registrations for the tobacco-related goods containing a shared term to co-exist on the Principal register may be used “to establish that [the] portion common to the marks involved in a proceeding has a normally understood and well-known meaning [and] that this has been recognized by the USPTO...; and that therefore the inclusion of [the shared term] in each mark may be an insufficient basis on which to predicate a holding of confusing similarity.

Id. (quoting *Red Carpet Corp. v. Johnstown American Enterprises Inc.*, 7 USPQ2d 1404, 1406 (TTAB 1988)).

Here, there are at least twenty-seven (27) third-party registrations on the Principal Register that include the word “kiss” or “kisses” and include personal cosmetic goods. (Dkt. 25, Applicant’s NOR Ex. 12). When asked if she was surprised that multiple products came back in the results when the word “kiss” was entered in the search engine on Walgreens’ website, Ms. Fufidio responded “That doesn’t surprise me.” (Dkt. 23, Fufidio Dep. 49:3-11). Ms. Fufidio agreed that “kiss” was a fairly common term in the beauty industry. (*Id.* at 49:12-15). Thus, Opposer has admitted that it is aware of the existence of third-party use of the marks incorporating the word “kiss” in the personal cosmetics space.

Like *Top Tobacco*, the existence of many third-party marks incorporating “kiss” or some variation thereof indicates that the shared and commonly used term “kiss” would be a weak basis for asserting a likelihood of confusion. *Top Tobacco LP v. North Atlantic Operating Co.*, 101 USPQ2d at 1173. Therefore, KISS as used by Opposer should be entitled to limited protection.

Similarly, there are at least three (3) third-party registrations on the Principal Register that include the words “my face” and include personal cosmetic goods:

Mark	Registration No.	Owner	Description of Goods
LOVE MY FACE	1,656,563	Revlon Consumer Products Corporation	Liquid makeup, pressed, powder, loose powder make-up and blushers (Int’l Class 3)
MYFACE.COSMETICS	3,390,122	MYFACE LLC	Cosmetics (Int’l Class 3)
MYFACE	3,944,504	MYFACE LLC	Cosmetics, namely, blushes, lip gloss, eye pencils, eye shadows, foundation, lipstick, face powder, make-up powder, and concealers (Int’l Class 3)

(Dkt. 25, Applicant’s NOR Ex. 12). The existing registration LOVE MY FACE is of particular significance to this analysis. (*Id.*). LOVE MY FACE is the exact same syntax that is at issue in this case—a three word phrase that includes a verb followed by MY

FACE. As evidenced by these other registrations, LOVE MY FACE and KISS MY FACE can coexist in the personal care products space without confusion among consumers. “Love” and “kiss” are more closely related than “touch” and “kiss.” If LOVE MY FACE and KISS MY FACE can coexist without confusing consumers, so can TOUCH MY FACE and KISS MY FACE.

“My face” is weak and highly suggestive of products that can be used on a consumer’s face. These third-party registrations are further indication that the non-distinct element MY FACE should be entitled to limited protection.

Opposer does not have the right to prevent others from using the word “kiss” in relation to personal cosmetic products, yet Opposer is requesting that Applicant be prevented from using TOUCH—a separate and distinct mark from KISS. These numerous third-party registrations and the third-party use of KISS in the personal cosmetics space indicates that consumers are able to understand and appreciate the differences between multiple marks (at least thirty-one (31) including Applicant) incorporating the word KISS or some variation thereof or MY FACE in the personal cosmetics space.

This factor weighs against a finding of likelihood of confusion.

D. FACTOR 4: THE CONDITIONS UNDER WHICH BUYERS TO WHOM SALES ARE MADE, I.E., “IMPULSE” VS. CAREFUL, SOPHISTICATED PURCHASING

There is no likelihood of confusion among consumers between Applicant’s mark TOUCH MY FACE and Opposer’s KISS MY FACE marks because the products are marketed as high-end natural beauty products to sophisticated consumers concerned with

their personal beauty products and such consumers carefully consider and research natural beauty products. Applicant actually sells the more expensive product.

The likelihood of confusion is reduced when the goods are sold to discriminating purchasers under conditions calculated to insure care in discerning the source or origin of the goods. *Indus. Nucleonic's Corp. v. Hinde*, 475 F.2d 1197, 1199, 177 USPQ 386, 387 (CCPA 1973). Sophisticated purchasers are less likely to be confused when the “goods are usually purchased after careful consideration by persons who are highly knowledgeable about the goods or services and their source.” *Elec. Design & Sales, Inc. v. Elec. Data Sys. Corp.*, 954 F.2d 713, 718, 21 USPQ2d 1388, 1392 (Fed. Cir. 1992). When the purchase price of the product is low, there is a greater chance that consumers will make impulse decisions and exercise less care in their purchases. *Recot, Inc. v. Becton*, 214 F.3d 1322, 1329, 54 USPQ2d 1894, 1899 (Fed. Cir. 2000).

Applicant's goods are sold at a high price to consumers who are thoughtful and discriminating about the condition of their skin. Dr. Roby Mitchell, President/CEO of Applicant, testified that Applicant's goods are sold to “women who have an interest in beauty...they will ask for things to help their skin look better.” (Dkt. 25, Applicant's NOR Ex. 2 June 30, 2014 Mitchell Dep. 5:11-18). Applicant's products are sold to consumers concerned about the appearance of their skin, and Applicant's products assist consumers to mitigate skin conditions. (*Id.* at 6:24-25, 7:2). Ms. Bytheway testified that Applicant's goods are sold in “Doctor's offices, pharmacies. We have I think one health food store.” (Dkt. 25, Applicant's NOR Ex. 3, Bytheway Dep. 7:22-23). Consumers purchasing skin

care products at Doctor's offices, pharmacies, and health food stores are thoughtful, careful purchasers rather than impulse buyers.

Likewise, Opposer's goods are sold to discriminating consumers that have an interest in all natural, higher-end beauty products. When asked about the target consumers for Opposer, Ms. Fufidio testified:

Our target market is women 24 to 39 years old, who we consider them to be – who they consider themselves to be natural thinking consumers. They're women who like natural products, understand the benefits of the product, and want products that are good and healthy for your skin. They usually have a higher income because natural products are a little bit more expensive, so that's who we're talking to.

(Dkt. 23, Fufidio Dep. 29:22-25, 30:2-7). Ms. Fufidio further testified that a consumer survey showed that sixty-eight percent (68%) of consumers that took the survey used words like all natural and earth friendly to describe Opposer's brand. (*Id.* at 18:15-25, 19:2-4). Words like "all natural" and "earth friendly" are not words associated with products purchased by impulse buyers—these types of products are targeted to sophisticated, thoughtful consumers willing to pay a premium for a premium product.

The products sold by Applicant and Opposer are not low-priced products which are purchased by consumers on an impulse. Applicant's product sells for between \$21.75-\$43.45. (Dkt. 20, Opposer's NOR Ex. 10, Dkt. 25, Applicant's NOR Ex. 3 Bytheway Dep. 10:6-25, Ex. 7 Request for Admission Resps. 39, 40). Opposer's products sell in a range of \$5.99-\$21.99. (Dkt. 23, Fufidio Dep. 29:6-16). According to Ms. Fufidio, these prices are "a little bit more expensive" and targeted at "higher income" consumers. (*Id.* at 29:22-25, 30:2-7). Applicant's product is priced at over twice the amount of Opposer's

expensive product. Both Applicant's products and Opposer's products are high-end beauty products purchased by careful, sophisticated consumers concerned about their beauty product purchases, not impulse buyers.

There is no likelihood of confusion among consumers because the end consumers are careful, sophisticated purchasers that do not purchase high-end natural beauty products as an impulse purchaser.

This factor weighs against a finding of likelihood of confusion.

E. FACTOR 7: THE NATURE AND EXTENT OF ANY ACTUAL CONFUSION; AND FACTOR 8: THE LENGTH OF TIME DURING AND THE CONDITIONS UNDER WHICH THERE HAS BEEN CONCURRENT USE WITHOUT EVIDENCE OF ACTUAL CONFUSION

There is no likelihood of confusion between Applicant's mark TOUCH MY FACE and Opposer's KISS MY FACE marks because the marks have been used concurrently in the marketplace for almost thirteen (13) years without a single instance of any actual confusion.

When marks have co-existed in the marketplace for a significant amount of time, it presents a reasonable opportunity for confusion to have occurred. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 637 F.3d 1344, 1354, 98 USPQ2d 1253, 1259 (Fed. Cir. 2011). The Board has previously found that "the most telling portion of the record" when determining the likelihood of confusion between the marks KENNETH KNITS and MALCOLM KENNETH KNITS was the lack of a single instance of confusion among marks that had coexisted over ten years. *Harry Fisher Corp. v. Kenneth Knits, Inc.*, 207 USPQ 1019, 1025 (TTAB 1980). Similarly, the coexistence in the marketplace of

champagne and beer for over ten years without any evidence of actual confusion “weigh[ed] against a holding of a likelihood of confusion.” *G.H. Mumm & Cie v. Desnoes & Geddes Ltd.*, 917 F.2d 1292, 1295, 16 USPQ2d 1635, 1638 (Fed. Cir. 1990).

There is no likelihood of confusion between TOUCH MY FACE and KISS MY FACE because the marks have been coexisting in the marketplace for almost thirteen (13) years without a single instance of actual confusion among consumers. The date of first use of Applicant’s mark TOUCH MY FACE is August 12, 2002, and Applicant has sold goods under the TOUCH MY FACE mark continuously since that date. (Dkt. 25, Applicant’s NOR Ex. 2 June 13, 2014 Mitchell Dep. 9:14-20; U.S. Ser. No. 85/663,155). Ms. Fufidio testified that she is unaware of a single instance of actual confusion among consumers between Applicant’s mark TOUCH MY FACE and Opposer’s mark KISS MY FACE. (Dkt. 23, Fufidio Dep. 51:16-25, 52:2-12). This is despite the fact that Ms. Fufidio testified that she believed TOUCH MY FACE and KISS MY FACE were in similar channels of trade and were exposed to the same consumers. (Dkt. 23, Fufidio Dep. 50:6-25, 51:2-4). In its Answers to Interrogatories, Opposer answered that it was not aware of a single instance of actual confusion among consumers between TOUCH MY FACE and KISS MY FACE. (Dkt. 25, Applicant’s NOR Ex. 9, Interrogatory Resp. No. 6). Opposer has never been contacted by any consumer, intentionally or unintentionally, about any type of connection or relationship between TOUCH MY FACE and KISS MY FACE. (Dkt. 23, Fufidio Dep. 51:16-25, 52:2-11).

Similar to *Harry Fisher* and *G.H. Mumm*, this lack of a single instance of actual confusion among consumers is a very telling portion of this record. Because Applicant’s

mark and Opposer's mark have coexisted for almost thirteen (13) years without a single instance of actual confusion is highly probative evidence that there is not a likelihood of confusion among consumers between TOUCH MY FACE and KISS MY FACE.

This factor weighs against a finding of likelihood of confusion.

VII. **CONCLUSION**

Consumers understand and appreciate the universal distinction between a "touch" and a "kiss," and consumers are not likely to be confused between TOUCH MY FACE and KISS MY FACE as to the source of the goods. A "touch" is not the same thing as a "kiss." TOUCH MY FACE and KISS MY FACE create separate, distinct impressions in the minds of consumers. TOUCH MY FACE and KISS MY FACE are not likely to cause confusion among consumers because:

1. Consumers will look to the dominant, first portions of the marks, TOUCH and KISS, rather than the shared, descriptive and highly suggestive shared element MY FACE. TOUCH and KISS differ in sound, appearance, and connotation and create separate and distinct commercial impressions in the eyes of consumers.
2. Opposer's KISS MY FACE marks are not strong when used in relation to personal cosmetic products, many of which are used on consumers' faces. This is further evidenced by Opposer's own required disclaimers and numerous third-party registrations and marks in the personal cosmetic space incorporating KISS or MY FACE. Opposer does not have the

exclusive right to MY FACE. Opposer's KISS MY FACE marks are not entitled to broad protection in the personal cosmetic space.

3. The goods sold using Applicant's mark and Opposer's marks are marketed and sold as all-natural, high-end beauty products to consumers concerned with their personal beauty products that will carefully consider and research all-natural beauty products. Applicant's product is more expensive than Opposer's product.
4. Applicant's mark and Opposer's marks have been used concurrently for almost thirteen (13) years, and during the time the marks have coexisted, there has not been a single instance of any actual confusion.

In determining the likelihood of confusion between Applicant's mark and Opposer's marks, the four factors listed above are most relevant factors to the Board's determination and confusion is clearly unlikely in this case. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d at 1361.

For the reasons stated herein, Applicant respectfully urges the Board to dismiss this Opposition proceeding and allow registration for Application Serial No. 85/663,155.

Dated: June 2, 2015

Respectfully submitted,

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ATTORNEYS FOR APPLICANT

CERTIFICATE OF SERVICE

This is to certify that a true and correct copy of the above and foregoing instrument was, this 2nd day of June, 2015, served upon counsel of record in this cause by placing same in the United States mail, first-class mail, properly stamped and addressed as follows:

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